



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,761	09/27/2001	Tzahi Arazi	1686/4	1790

7590 01/15/2003

DR. MARK FRIEDMAN LTD.
c/o Bill Polkinghorn
Discovery Dispatch
9003 Florin Way
Upper Marlboro, MD 20772

EXAMINER

WINKLER, ULRIKE

ART UNIT	PAPER NUMBER
----------	--------------

1648

DATE MAILED: 01/15/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/963,761

Applicant(s)

ARAZI ET AL.

Examiner

Ulrike Winkler, Ph.D.

Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-35 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 1648

DETAILED ACTION

Formal drawings and photographs have been submitted which fail to comply with 37 CFR 1.84. Please see the form PTO-948.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

A. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

B. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.185(a). Failure to take corrective action within the set (or extended) period will result in **ABANDONMENT** of the application.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-22, drawn to a recombinant potyvirus vector, classified in class 435, subclass 320.1.
- II. Claims 23-27, drawn to a method of using the recombinant potyvirus vector to transiently express a heterologous protein in a plant, classified in class 800, subclass 278.

Art Unit: 1648

III. Claims 23-27, drawn to a method of vaccination using a plant virion, classified in class 424, subclass 9.2.

For the invention of group I above, restriction to one of the following is also required under 35 USC 121. Therefore, if applicant elects the invention of group I, election is further required for one of inventions (1)-(75).

1. ZYMV,
2. ALMV,
3. AmLMV,
4. ArjMV,
5. ArLV,
6. AV-1,
7. BCMV,
8. BCNMV,
9. BYMV,
10. BtMV,
11. BiMoV,
12. CdMV,
13. CVMV,
14. CTLV,
16. CeMV,
17. ChiVMV,
18. CIYVV,
19. CSV,
20. CDV,
21. ComMV,
22. CABMV,
23. CGVBV,
24. DsMV,
25. DSTV1
26. DeMV,
27. GSMV,
28. GEV,
29. GGMV,
30. HVY,
31. HmV,
32. HiMV,
33. IFMV,
34. IMMV,
35. ISMV,

Art Unit: 1648

36. JGMV,
37. KMV,
38. LYSV,
39. MDMV
40. NDV,
41. NYSV,
42. NoMV,
43. OYDV
44. ORMV,
45. BRSV,
46. PARMV,
47. PWV,
49. PSBMV,
50. PEMOV,
51. PEPMOV,
52. PESMV,
53. PVMV,
54. PTV,
55. PPV,
56. PKMV,
57. PVA,
58. PIIV,
59. PVY,
60. RETBV,
61. SRMV,
62. SMV,
63. SCMV,
64. SPYFV,
65. TAMMY,
66. TEMV,
67. TEV,
68. TBBV,
69. TBV,
70. TSBV,
71. TUMV,
72. WMV-2,
73. WylidV,
74. YMV,
75. ZYFV.

Art Unit: 1648

For invention of group I above, restriction to one of the following heterologous nucleic acid sequences is also required under 35 USC 121. Therefore, if applicant elects group I, election is further required for one of the heterologous sequences (A)- (E).

- (A) cMyc; SEQ ID NO: 8-19, 31
- (B) FMDV; SEQ ID NO: 20-24
- (C) His-Tag; SEQ ID NO: 4-7
- (D) Ovalbumin; SEQ ID NO: 28-30
- (E) AGII Coat Protein; SEQ ID NO: 25-27

The inventions are distinct, each from the other because of the following reasons:

Inventions (1)-(75) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions, represent structurally different polynucleotides. Therefore, where structural identity is required, such as for hybridization, expression or activity, the different sequences have different effects.

Inventions (A)-(E) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions, represent structurally different polypeptides and the polynucleotides encoding them. Therefore, where structural identity is required, such as for expression or activity, the different sequences have different effects.

Art Unit: 1648

Group I is drawn to compositions and is distinct from groups II and III, which are drawn to methods. The compositions of group I: (1)-(75) are distinct from each other because they contain different polynucleotide sequences which have different structures. Groups II and III are drawn to methods and each is distinct from the other because they utilize different starting materials, therefore the outcomes are not be expected to be the same. Group II is drawn to utilizing a recombinant vector for expression in plant cells. While group III is drawn to a method of vaccination utilizing a potyvirus construct

Claim 1 link(s) inventions 1-75 and A-E. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claim 1. Upon the allowance of the linking claim, the restriction requirement as to the linked inventions shall be withdrawn and any claim depending from or otherwise including all the limitations of the allowable linking claim will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification, and the literature and sequence

Art Unit: 1648

searches required for each of the Groups are not required for another of the Groups, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).


Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ulrike Winkler, Ph.D. whose telephone number is 703-308-8294. The examiner can normally be reached M-F, 8:30 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached at 703-308-4027.

The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 or for informal communications use 703-308-4426.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.


Ulrike Winkler, Ph.D. 1/8/03